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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,064	11/19/2003	Tatsuki Matsumoto	NEKO 20.738	7229

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EXAMINER

AFSHAR, KAMRAN

ART UNIT PAPER NUMBER

2617

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,064

Applicant(s)

MATSUMOTO, TATSUKI

Examiner

Kamran Afshar, 571-272-7796

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,5,8,9 and 11-16 is/are rejected.
7) ☐ Claim(s) 2-4, 6-7, 10 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

1. Applicant's arguments filed 09/28/2006 have been fully considered but they are not persuasive.

The Applicant has argued that Heinonen does not disclose or suggest any feature of the master-slave relationship. Examiner very kindly directs the Applicant that Heinonen does (either inherently and / or obviously) discloses the master-slave relationship internal to the mobile device that is exchange of the data and of information (See e.g., Master control state (MCU), slave state, Co. 4, Lines 23-29, Co. 13, Lines 13-22, Co. 14, Lines 30-42). Lahteenmaki specifically establishes the inherent and / or obviousness by explicitly disclosing the communications (that is exchange of information) between the wireless communications terminal, the smart card reader and the smart card inserted to the latter is carried out using a vigorously well known master-slave principle (or relation or protocol) in the art (See Lahteenmaki e.g. Lines 1-4 of ¶ [0068]). Also, Applicant has argued that the Lahteenmaki does not discloses means for restricting execution of a service that incurs payment except for a telephone call services based on information. Applicant is kindly directed to Heinonen where explicitly discloses this which states that the information about call restrictions is saved on an add-in card (such as SIM card, Smart card, etc.) which the user has to install in the mobile phone when it is being used. Thus the main use of this method is to prevent the use of some properties of the mobile phone and / or possibly to restrict the use of the phone by preventing from services that may special service fee or payment may occur. In this instant: foreign calls, long-distance calls or calls to service numbers (See Heinonen e.g. Co. 2, Lines 7-17). In response to applicant's argument that there is no suggestion to combine the Heinonen and Lahteenmaki references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In*

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re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Therefore, the previous rejection is maintained.

1 Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5, 8-9, 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heinonen (U.S. Patent 6,078,806) in view of Lahteenmaki (U.S. Pub. No.: 2003/0183691 A1).

With respect to claims 1, 5, 9, Heinonen discloses the method and / or a portable telephone terminal device (See Heinonen e.g. Co. 2, Line 8, mobile phone) comprising: a recording medium adapted to record information of a subscriber and / or arrangement for receiving request for a special fee (See Heinonen e.g. ad-in card, Smart card, SIM card, User Identity Module UIM card, Subscriber Identity Module card SIM, or Universal Subscriber Identity Module USIM card, etc. Co. 2, Line 9), and means for restricting execution of a service that incurs payment except for a telephone call services based on information (See Heinonen e.g. long distance call restriction information, foreign calls, service calls, etc. Co. 2, Lines 7-16). In the same field of endeavor, Lahteenmaki also discloses the method and / or a portable telephone terminal device comprising a comprising: a recording medium adapted to record information of a subscriber (See Lahteenmaki e.g. ad-in card, Smart card, SIM card, User Identity Module UIM card, Subscriber Identity Module card SIM, or Universal Subscriber Identity Module USIM card, etc. Page 4, Line 4-10 of ¶ [0065]). Further Lahteenmaki discloses the well know arrangement for receiving and / or master-slave relation the recoding medium (See Lahteenmaki e.g. Page 5, ¶ [0068]). Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention to provide above teaching of Lahteenmaki to Heinonen to implement use of well know master/slave communication or relation or protocol so that an arrangement is designed to enable electronic payment of purchases made

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with a mobile terminal or mobile phone (See Lahteenmaki e.g. Page 1, Lines 3-6 of ¶ [0004]) and / or to implement a new mobile station and a new system for effecting payments which is preferably arranged for a certain use, such as a credit card, a cash card or a payment card; and also offer special services, like time tables for public transportation or exchange rates (See Heinonen, Co. 2, Lines 24-31).

Regarding claim 8, Heinonen discloses recording medium is one of a User Identity Module (UIM) card, a Subscriber Identity Module (SIM) card, and a Universal Subscriber Identity Module (USIM) (See e.g. Co. 1, Lines 13-20).

Regarding claim 11, 13, 15, it is obvious that the master-slave relation is between the portable telephone terminal device and a second terminal device (See Heinonen e.g. See e.g. Fig. 7, Co. 12, Lines 8-20).

Regarding claims 12, 14, 16, it is obvious that the portable telephone terminal device and the second terminal device do not communicate directly (See Heinonen e.g. Figs. 5-6).

Allowable Subject Matter

4. Claims 2-4, 6-7 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kamran Afshar whose telephone number is (571) 272-7796. The examiner can be reached on Monday-Friday.


If attempts to reach the examiner by the telephone are unsuccessful, the examiner's supervisor, **Eng, George** can be reached @ (571) 272-3984. The fax number for the organization where this application or proceeding is assigned is **571-273-8300** for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kamran Afshar

12/4/2006



GEORGE ENG
SUPERVISORY PATENT EXAMINER